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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,641	01/29/2004	Gernot Schmierer	DFS-170-A	5404

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EXAMINER

OKEZIE, ESTHER O

ART UNIT PAPER NUMBER

3652

DATE MAILED: 04/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10767,641	Applicant(s) SCHMIERER ET AL.	
	Examiner Esther O. Okezie	Art Unit 3652	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 March 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: 19-21.

Claim(s) rejected: 1-18 and 22-24.

Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____

13. ☐ Other: _____.


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Continuation of 11. does NOT place the application in condition for allowance because:

1) Applicant has argued that while Boyd et al US 5,799,661 discloses a suction device having a contact surface textured by bumps to create high friction, the reference does not disclose bumps having a length two to twenty times greater than the thickness of the bumps. It is brought to Applicant's attention that this limitation was previously treated in the Final Rejection of November 30, 2005:

"....Boyd et al discloses the height of the bumps as 1mm and the geometry and the pattern of the bumps creates a reliable grip on the surface of the heart tissue (col. 19, lines 1-12). Boyd et al does not disclose the thickness of the bumps. It would have been obvious to one of ordinary skill in the art to construct the bumps to be thick enough to provide a "reliable, flexible, friction grip" but slender enough to prevent damaging the heart tissue."

Furthermore, Applicant has disclosed, "It has been shown that high shear forces can be transmitted if the length of the elements is two to twenty times, specifically five to ten times, greater than their thickness or diameter. In addition optimal packing density is achieved..." (Specification, page 3, lines 13-15). It has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

2) Applicant has argued the Boyd reference is not analogous art. In response to applicant's argument that Boyd is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the suction device of Boyd is used for picking up heart tissue which is difficult to grasp during cardiac procedures. Applicant's suction device is applied to work pieces with surfaces that are difficult to grasp, such wet or oily surfaces. Consequently, Boyd is analogous art because the device of Boyd provides a solution for picking up items that are difficult to grasp in a similar manner that Applicant's device attempts to provide a solution for the same problem.

3) Applicant has argued that Reimann et al US 6,203,083 does not disclose a flexible suction body. In response, the sections that make up the suction body of the device, including the elastomeric insert 3, annular bearing member 8, and the base body 2 are all described as deformable. The reference discloses that the bearing member has lower deformability and reduced elastic deviation than the base body in order to more securely hold an item being sucked (col. 1, lines 55-65). The fact that the bearing member has lower elastic deformability than the base member supports the fact that suction body is flexible since elastic deviation is present in all of the components in order to more securely hold components against a surface that is elastic rather than a hard surface, which is one of the objectives of the invention (col. 1, lines 5-22).